

REMARKS

Claim 21 has been amended to address the objection in paragraph 1 of the Office Action. The Abstract has been shortened and the specification has been corrected on page 13 line 4, as requested in paragraphs 8-10 of the Office Action. Claims 11 and 12 have been rewritten in independent form to secure their allowance and overcome the objection in paragraph 7. The indication of allowance of all the claims but 1 and 3 in paragraph 6 is noted with thanks.

Claim 1 is still rejected over Hawkins '673 and the Examiner indicates the Applicant's arguments are not persuasive. With due respect, it appears the Examiner is reading claim one differently than it is currently worded. Claim 1 now requires the seal to be telescopically movable with respect to the mandrel **"to engage"** the interior annular surface adjacent the thread. The thread is recited to be in the upset or the coupling in the preamble of claim 1.

A close look at Hawkins Figures 3a or 4 indicates that the seal 29 must first contact the casing 32 so that the mandrel 20-24 can continue to progress relatively to the now stationary seal 29 and compress spring 25. In other words, the relative movement in Hawkins can only occur after the seal 29 is jammed into contact with the casing 32. Claim 1, on the other hand requires the relative movement to occur in order to create the contact between the seal and the tubular in the first place.

The Examiner reads the Hawkins items 82 and 84 as part of a seal. Items 82 and 84 are shown in Figure 3. The structure in Figure 3 is a length extender that is connected between a top drive and the mandrel that begins for example at the top of Figure 3a. In fact the threads in lower sub 84 would be engaged to the threads 19a in Figure 3a. As

such, items 82 and 84 have nothing to do with a seal on the mandrel. In Hawkins, the only seal is the cup seal 29 that is slidably mounted to the mandrel 19. Again, the slidable movement of seal 29 with respect to mandrel 19 only occurs after seal 29 is in contact with the tubular. Claim 1 slidably moves the seal with respect to the mandrel to make initial contact with the tubular. Hawkins does not anticipate claim 1.

The Examiner cites Stokley as anticipating claim 1. Specifically, the Examiner refers to Figure 7 and claims that seal 158 is “adjacent” the female thread of coupling C in that Figure. When discussing the Hawkins reference in paragraph 5 of the Office Action, the Examiner states that “adjacent” is a relative term. The problem with the Examiner’s perspective is that it ignores the more restrictive claim language of claim 1. Specifically, claim 1 recites an upset or coupling at the end of the tubular. It also states that the upset or coupling have a thread and at least one annular surface adjacent the thread. What this means is that the seal is making contact on the annular surface that has previously been described as being in the coupling or upset **and** adjacent the thread that is **in** the coupling or upset. Figure 7 of Stokley shows an inflatable seal 158 that is not in the coupling. Indeed it can’t be in the coupling because it would then be too close to the threads so that when it was inflated it either would not seal or it would rupture on a burr or sharp spot on the threads. In fact, Stokley’s Figure 7 expressly teaches away from the specific claim language in claim 1.

Allowance of claims 1 and 3 is requested.

Respectfully submitted,

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